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Docket No.: 1793.1148

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

So-hye KIM et al.

Serial No. 10/750,215

Group Art Unit: 2609

Confirmation No. 6657

Filed: January 2, 2004

Examiner: Richard Z. ZHU

For: PRINTING METHOD USING NUP FUNCTION, AND COMPUTER READABLE
RECORDING MEDIUM STORING COMPUTER PROGRAM FOR EXECUTING THE
PRINTING METHOD

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This is responsive to the Office Action mailed July 12, 2007, having a shortened period for response set to expire on August 12, 2007, the following remarks are provided.

I. Provisional Election of Claims Pursuant to 37 CFR §1.142

Applicants provisionally elect Group I, claims 1, 2, 8, 22, and 24, in response to the election requirement set forth in the Office Action.

II. Applicants Traverse the Requirement

Lack of Required Requirement Rationale

Applicants submit that the outstanding election requirement is improper.

The Office Action fails to provide any evidence or even discussion regarding the requirements under MPEP §803, which sets forth the particular requirements that the Examiner must meet before a prima facie restriction/election requirement has been set forth.

MPEP §803 sets forth the criteria for restriction between patentably distinct inventions. (A) indicates that the inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05-806.05(i)); and (B) indicates that there must be a serious burden on the Examiner if restriction is required (see MPEP §803.02, §806.04(a)- §806.04(i), §808.01(a) and §808.02).

Further, a conclusory statement is insufficient. For both the required independence-distinctness and the Examiner's serious burden particular rationales must be set forth in the election/restriction requirement.

This is evidenced by the fact that pages 3 and 4 of the Office Action, which recite the required support for the independence-distinctness and the Examiner's burden, have no relationship with the current application, i.e., they appear cut and paste from a generic template.

For example, in indicating the independence-distinctness of the purported species, the Examiner particularly recites:

"[t]he species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of each species. In addition, these species are not obvious variants of each other based on the current record."

Here, the Examiner has not determined whether the purported species are independent or distinct, but only concludes that they must be one of the two.

Similarly, the Office Action merely indicates that: "[t]here is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics....and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph."

The recited "burden" requirement merely is a template capable of covering any species and any claim set.

These independence-distinctness and burden supporting rationales are not specific or even related to the pending claims.

As the Examiner has already once reviewed all the pending claims and all the pending claim features, and previously not found the required independence-distinctness and burden requirements for restriction/election, it is respectfully submitted that a complete reversal of the Examiner interpretation of the claims and previous searches requires more than a conclusory statement of the above requirements before requiring election.

For example, in the previous Office Action, the Examiner believed the claims should all be maintained in the current application. Further, it appears that an extensive search has already been performed by the Examiner. The previous Office Action set forth two 35 USC § 102 rejections based upon two different references, identified further related references on page 12 of the Office Action, and as evidenced by the attached Appendix, the Examiner has reviewed four Information Disclosure Statements, cited five U.S. patents and five non-patent documents in

the previously supplied PTO-892, and appears to have performed an extensive search as evidenced by the Examiner's Search Notes.

Thus, in addition to the Office Action failing to provide the required rationale for supporting the election requirement, it is further respectfully submitted that no serious burden will be imposed on the Examiner in further prosecuting all the pending claims in the present application.

Improper reference to Species in Office Action

In addition to the above, it is further noted that MPEP §809.02(a) sets forth that the Examiner is required to set forth particular citations to the purported different species.

However, page 1 of the Office Action merely cites portions of the Summary of the present application, which are merely repetitions of the originally filed claims. This citation to the Summary does not meet the required "clearly identify... each of the disclosed species, *to which the claims are ... restricted.*"

Applicants respectfully request the Examiner point to portions of the detailed specification supporting the Examiner's Species determination.

III. Conclusion

In view of the foregoing, applicants respectfully submit that the outstanding restriction requirement is improper. Withdrawal of this requirement is respectfully requested.

If any further fees are required in connection with the filing of this Amendment, please charge the same to our deposit account number 19-3935.

Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

Respectfully submitted,

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Date: 8/7/07

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